

REMARKS

Request for Acknowledgement of Information Disclosure Statement

A Supplemental Information Disclosure Statement (IDS) was filed on May 6, 2004 by the Applicants. The Examiner has not acknowledged the receipt of this Information Disclosure Statement, which has been entered in the image file wrapper. Applicants respectfully request that the Examiner provide initialed copy of the previously filed PTO1449 form with the next office action. A copy of the PTO1449 form that was submitted with the IDS mentioned above is attached to this paper for the Examiner's convenience.

In the outstanding Office Action¹, the Examiner took the following actions:

- I. rejected claims 3-5, 34, and 37-39 under 35 U.S.C. § 112, first paragraph,
- II. rejected claims 4 and 5 under 35 U.S.C. § 112, second paragraph,
- III. rejected claims 1, 2, 35, and 36 under 35 U.S.C. § 102(b) as being anticipated by Yamazaki (U.S. Patent No.: 5,306,940),
- IV. rejected claims 3, 4, 34, and 37 under 35 U.S.C. § 102(b) as being anticipated by Miyawaki et al. (U.S. Patent No.: 5,567,962) ("Miyawaki"), and
- V. rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Miyawaki.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants declines to automatically subscribe to any statement or characterization in the Office Action.

By this Amendment, Applicants cancel claims 1-5 and 34-37, and amend claims 38 and 39 to be written in independent form including all of the limitations of their respective base claims 1 and 2. Since only claims 38 and 39 remain pending, Applicants note that Examiner's rejections pertaining to claims other than claims 38 and 39 are moot. Hence, Applicants will only address the rejection of claims 38 and 39 under 35 U.S.C. § 112, first paragraph, in this response and respectfully request a withdrawal of all rejections.

Rejection of Claims 38 and 39 under 35 U.S.C. § 112, first paragraph

Applicants respectfully traverse the Examiner's rejection of claims 38 and 39 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner states that "the specification never discloses the gate electrode is a metal gate electrode, and said gate insulating film being formed on top surface and sides of the semiconductor layer in each of said element regions which are not covered with said element isolating insulating film as claimed in claims 38 and 39." (Office Action, p. 2) Although Applicants respectfully disagree with the Examiner's assertion that "the gate electrode is a metal gate electrode" is not disclosed in the specification, Applicants have nonetheless deleted "a metal gate electrode" from claims 38 and 39. In addition, Applicants respectfully direct the Examiner's attention to the following portions of Applicants' specification:

- a) Paragraph [0043] recites "present invention comprises a substrate having a semiconductor layer, an element isolating insulating film for partitioning the semiconductor layer into a plurality of element regions, the element

isolating insulating film being formed on the substrate...having a top surface projecting upward above a surface of the semiconductor layer."

- b) Figure 19B depicts gate insulating film 73 formed on the top surface and sides of the semiconductor substrate 71 in each of the element regions which is not covered with element isolating insulating film 72.

In light of the items a) and b) above, Applicants submit that amended claims 38 and 39 fully comply with the requirements of 35 U.S.C. § 112 and respectfully request withdrawal of this rejection.

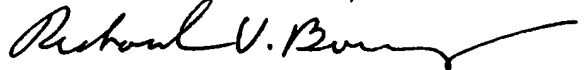
Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

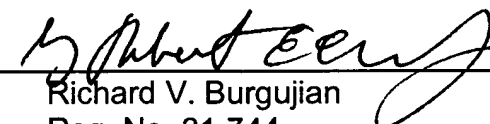
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.



Dated: July 20, 2006

By:  #27,432
Richard V. Burgujian
Reg. No. 31,744